

#8 Reg for
EJH/Revised
3/18/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue Applicant: David E. Hirth
Patent No.: 6,079,496
Serial No.: 09/939,227
Filing Date: 08/26/2001
Title: Reduced Shock Landing Collar

§
§
§
§
§
§
§

Group Art Unit: 3672
Examiner: Frank Tsai
Docket No.: D5407-25

GROUP 3600

MAR 14 2003

RECEIVED

Commissioner of Patents
Washington, D.C. 20231

RESPONSE TO OFFICE ACTION

Claim 7 of the issued patent is now rejected, again, over O'brien. The Examiner points to Figures 2 and 3 of O'brien and concludes that the movement regulation device is anticipated by shear pin 56 "which yields until a predetermined fluid pressure is applied." The Examiner has skipped over that portion of claim 7 that refers to the movement regulation device which states that it is "operable on said seat assembly to selectively regulate movement from said first to said second position." O'Brien's shear pin 56 can't do this. It may yield for some movement of seat 60 while yielding, but it very quickly shears or fails, as it is designed to do. However, shear pin 56 fails well before the seat 60 has reached the second position of Figure 3. In summary, O'Brien's device is incapable of regulation of movement of a seat assembly from a first to a second position as those positions are defined in claim 7.

Furthermore, claim 1 is allowed and claim 7 has the identical language and then additional elements. Applicant fails to understand how a broader claim 1 can be allowed while claim 7 that has the same language and a fluid chamber with a changing volume. The Examiner relies on the space between body 10 and seat 60 and concludes that such

structure meets the element in claim 7 for the fluid chamber. Yet the Examiner points to nowhere is the drawing or the specification to show that movement of the seat changes the volume of this chamber. In fact the volume between seals 40 and 42 of O'brien never changes as seat 60 moves down. For these 3 specific reasons given above, the anticipation rejection of claim 7 under §102(b) is respectfully requested to be withdrawn.

There is no prior art cited against claims 21-36 as the basis for rejection. Instead, the Examiner, again, contends that these claims are tantamount to an attempt to recapture subject matter surrendered in the application upon which this reissue application is based. The stated basis for the rejection is 35 U.S.C. 251. This time the Examiner's rejection appears to be based on the amendment to claims 1 and 13 in the previous application to distinguish O'brien. That amendment related to the selective regulation of the rate of movement from the first to the second position.

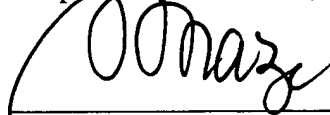
As a first matter, claim 23 recites movement regulation by displacement of fluid from a cavity through an outlet that presents a flow restriction. That language meets the limitation added to claims 1 and 13 in the previous application and is, in fact, narrower. It is more specific as to how the regulation is accomplished, reciting fluid displaced from a cavity through a flow restriction. Therefore, under the *Clement* case cited by the Examiner and the discussion in MPEP §1412.02 there is no basis to reject claims 23-33 under 35 U.S.C. §251 because the reissue claim "is narrower in all respects, the recapture rule does not apply..." Claim 23 is narrower in the respect that it adds the non-metallic body from claim 21; a narrowing feature unrelated to past rejections and it recites the movement regulation in greater structural detail.

The Examiner also cites the recapture rule against claims 21-22 and 34-36. The following portion from MPEP §1412.02 is relevant,

“If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture.

Claim 21 includes the non-metallic body. The addition of this significant limitation has modified the claim significantly so as to alter the scope of the claim so as to preclude recapture of the rate of movement regulation. As stated in the MPEP, the narrowing limitation of the non-metallic body precludes the application of recapture. This is a broadening reissue filed within 2 years of the issue of the underlying patent to cover a structure that could have been claimed but wasn't in the original application, hence the error that is the grounds for this application. Claim 21 is focused on a non-metallic body having a seat to accept an object for pressure buildup and that facilitates subsequent milling for full bore access. It has no movement or regulation of movement recited. Its focus is on the construction material of the body and the subsequent benefits of a non-metallic structure. There is simply no recapture under these circumstances.

Respectfully submitted,



March 7, 2003

Gary R. Maze
Reg. No. 42,851
Duane Morris LLP
One Greenway Plaza, Suite 500
Houston, TX 77046
Tel.: 713.964.7700

Fax: 713.964.7701

CERTIFICATE OF MAILING 37 CFR 1.8(a)

I hereby certify that a copy of this document along with any referred to as attached or enclosed is being deposited with the United States Postal Service as First Class mail, postage prepaid in an envelope addressed to Commissioner for Patents, Washington, D.C. 20231, on March 7, 2003.

Naci Mugpa

3672



PTO/SB/21 (01-03)
 Approved for use through 04/30/2003. OMB 0651-0031
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
 Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/939,227
	Filing Date	08/24/2001
	First Named Inventor	David E. Hirth
	Art Unit	3672
	Examiner Name	Frank Tsay
Total Number of Pages in This Submission	Attorney Docket Number	D5407-25

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<div style="border: 1px solid black; padding: 10px; width: fit-content; margin: auto;"> <p>RECEIVED MAR 14 2003 GROUP 3600</p> </div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual	Gary R. Maze, Reg. No. 42,851, Duane Morris LLP
Signature	
Date	03/07/2003

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: 03/07/2003			
Typed or printed	Tracie Thigpen		
Signature		Date	03/07/2003

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.